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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,552	06/14/2001	Darryl W. Peters	5709	6836

7590 08/07/2003  
Martin Connaughton  
Ashland Inc.  
P.O. Box 2219  
Columbus, OH 43216

EXAMINER

WEBB, GREGORY E

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 08/07/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/881,552

Applicant(s)

PETERS ET AL.

Examiner

Gregory E. Webb

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

#### ***Claim Rejections - 35 USC § 112***

1. Previous rejections to claim 15 under 35 U.S.C. 112, second paragraph, are withdrawn.

#### ***Claim Rejections - 35 USC § 102***

2. Claims 1-15 remain rejected under 35 U.S.C. 102(b) as being anticipated by Tanabe et al.

#### ***Response to Arguments***

3. Applicant's arguments filed 6-9-03 have been fully considered but they are not persuasive. The applicant argues that the prior art compositions do not meet the applicant's buffer requirement.

4. It is important to note the applicant's buffer limitation:

"comprising .. B. a buffer, wherein the aqueous, buffered, fluoride containing composition has a pH greater than 7.0 to about 11.0."

5. It should be noted that the applicant has not defined the type of buffer used, the amount of buffer used or the extent of the buffering (i.e. slightly buffered or highly buffered).
6. The examiner must read these terms as broadly as possible. Many compounds will buffer a solution to different extents and the amount required will also determine the extent of buffering.
7. The applicant's figure 1 represents a composition with a drop in pH. This figure does not demonstrate that buffering fails to occur. It only demonstrates that the composition of figure 1 is

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less buffered than that of figure 2. One cannot state that figure 1 represents a completely unbuffered solution as only 3 data points are demonstrated. Furthermore, this diagram *does not* represent the prior art compositions.

8. The applicant provides a definition of buffering and buffers on page 5 of the instant specification. The applicant states the following (see line 24):

"In addition compositions not normally thought of as useful buffers such as benzotriazole, selected biological compositions like glycine or vanillin and the like can be used."

9. From this statement it is clear that a broad range of compounds can function as buffers. Furthermore, Tanabe et al clearly teaches the use of various compounds meeting this broad definition including the benzotriazole (see Tanabe et al, col. 5, lines 35-41 and example 4).

10. It is not clear to the examiner how this compound would not provide at least some buffering to the solutions of the prior art. As the applicant has not provided limitations defining the extent of buffering and has provided no data demonstrating any deficit in the prior art, the examiner must maintain the position that the prior art compositions meet this very broad buffering limitation.

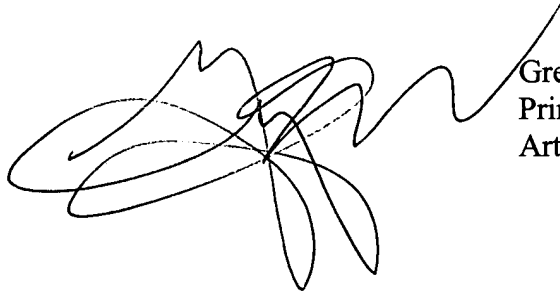
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 703-305-4945. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, consisting of several loops and a long horizontal stroke extending to the right.

Gregory E. Webb  
Primary Examiner  
Art Unit 1751

gw  
August 5, 2003